



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

VB

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/292,862	04/16/99	WALTER	M 07540/020003

KRISTINA BIEKER-BRADY PH D
CLARK & EBING LLP
176 FEDERAL STREET
BOSTON MA 02110

HM22/0621

EXAMINER

TURNER, S

ART UNIT	PAPER NUMBER
----------	--------------

1644

9

DATE MAILED:

06/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/292,862

Applicant(s)

Walter et al

Examiner
Sharon L. Turner, Ph.D.

Group Art Unit
1644



☒ Responsive to communication(s) filed on 10-18-99

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-17 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-17 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1644

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-5, 8, 11, 15-17 drawn to a method of diagnosing eye disease with nucleic acids, classified in class 536, subclass 23.6.
 - II. Claim 6, 9, drawn to nucleic acids and kit, classified in class 536, subclass 23.1.
 - III. Claim 7, 11, 12, 15-17 drawn to a method of diagnosis with peptide, classified in class 530, subclass 300.
 - IV. Claims 10, 13, drawn to a method of detecting treatment compounds, classified in class 530, subclass 300.
 - V. Claim 14, drawn to gene therapy, classified in class 514, subclass 44.
2. The inventions are distinct, each from the other because of the following reasons:
3. Groups ^{I and III - V}~~I-III~~ are related as processes. The processes of groups ^{I and III - V}~~I-III~~ are different each from the other as they comprise different steps, use different components and perform different functions, for example treating with either a protein or a nucleic acid or assaying for compounds which treat and creating transgenic cells.
4. Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP

Art Unit: 1644

§ 806.05(h)). In the instant case the nucleic acids may be used for amplification or for the creation of transgenic cells. The methods could be practiced with an alternative FREAC allele.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and recognized divergent subject matter restriction for examination purposes as indicated is proper.

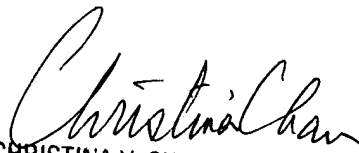
6. Because these inventions are distinct for the reasons given above and the search required for each of the groups is not required for any other group, restriction for examination purposes as indicated is proper.

7. Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1600 is (703) 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to, Sharon L. Turner, Ph.D. whose telephone number is (703) 308-0056. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan, can be reached at (703) 308-3973.

Sharon L. Turner, Ph.D.
June 19, 2000


CHRISTINA Y. CHAN
SUPERVISORY PATENT EXAMINER
GROUP 1800/1640